REMARKS

This paper is submitted in response to the Office Action mailed November 4, 2005. The Applicant respectfully requests that the following Remarks be entered into the official file pertaining to the subject application.

Per this paper, claims 1-24 remain pending in the subject application. Claims 1-24 stand rejected.

I. Rejection of Claims 1-24 under 35 U.S.C. § 103(a)

At paragraph 4, spanning pages 2 through 15 of the Office Action, the Examiner rejects claims 1-24 under 35 U.S.C. § 103(a). According to the Examiner, claims 1-24 would have been obvious based on U.S. Patent No. 6,320,947 to Joyce, et al. ("Joyce") in view of U.S. Patent No. 6,430,276 to Bouvier, et al. ("Bouvier") and further in view of U.S. Patent No. 5,684,965 to Pickering ("Pickering").

The Applicant respectfully TRAVERSES the Examiner's rejection and asserts the following remarks in response.

In order for the Examiner to establish a *prima facie* case for obviousness, three (3) criteria must be met. First, there must be some suggestion or motivation, either in the cited prior art references or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as the Examiner proposes. Second, there must be a reasonable expectation of success in connection with the Examiner's proposed combination of the references. Third, the prior art references must disclose or suggest all of the claimed limitations. *See* MPEP 2143. The Examiner has failed to establish a

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prima facie case for obviousness because the Examiner failed to satisfy his burden of showing that the prior art discloses or suggests all of the claimed limitations of claims 1-24 and, as such, failed to satisfy his burden of showing that there is a suggestion or motivation to one of ordinary skill in the art to modify the primary reference as the Examiner proposes.

The Applicant's independent, system claims 1, 6, and 21 each recite, *inter alia:*

> . . . a billing facility configured to permit said users to establish a **billing allocation scheme between a first party and second party** to be used to control the billing of services that are provided within said access controlled environment and are **associated with a particular transaction,** and to consolidate data related to internal operations performed by said access control facility, said transaction management facility, and said authentication facility to generate and process billing data based at least on said billing allocation scheme, wherein said billing data indicates a first monetary amount associated with said services, which is to be billed to the first party, and a second monetary amount associated with said services, which is to be billed to the second party, **wherein each of the first monetary amount and the second monetary amount are an amount greater than zero, and the first party is different than the second party.** (emphasis added).

The Applicant's independent, method claims 11 and 16 each recite, *inter alia:*

> permitting said user to establish **a billing allocation scheme between a first party and a second party** to be used to control the billing of services that are provided within said access controlled environment and are **associated with a particular transaction**; and
> at a billing facility operating within said access controlled environment, consolidating data related to internal operations performed by said access control facility, said transaction management facility, and said authentication facility, generating and processing billing data based at least on said billing allocation scheme, wherein said billing data indicates a first monetary amount associated with said services, which is to be billed to the first party, and a second monetary amount associated with said services, which is to be billed to the second party, **wherein each of the first monetary amount and the second monetary amount are an amount**

greater than zero, and the first party is different than the second party.
(emphasis added).

The Applicant's claimed invention addresses the issue of establishing a billing allocation scheme by an authenticated user(s) in a multi-party transaction via a network. The monetary charges incurred in the multi-party transaction may be allocated or billed to each of the parties involved therein and is determined, in part, on the billing allocation scheme.

First, the Examiner wrongly bases his rejection on Joyce as the primary reference. Joyce contemplates and teaches that there is **only one party, i.e., the user, who will be billed or charged for any services**. Thus, there can never be any distribution of expenses between parties involved in a transaction because only the user of the system is charged for services (i.e., the entity operating or providing the system does not charge itself for services which it provides to the user, and there are no other parties involved in the transaction). **Thus, there is no need in Joyce for the user to establish a billing allocation scheme between different parties involved in the same transaction, as required by independent Claims 1, 6, 11, 16, and 21 and no such allocation scheme is even suggested or contemplated**. Moreover, since any allocation as described by Joyce is always allocated to one user (i.e., 100%) there is no incentive to allow the user to establish a billing allocation scheme between two separate parties. Thus, **one of ordinary skill in the art would not have been motivated to modify the system and method described by Joyce to include the Applicant's claimed billing allocation scheme, and the Examiner's rejection based upon Joyce as the primary reference is**

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improper.

At page 3 of the Office Action, the Examiner states that Joyce fails to teach "a billing allocation scheme between a first party and a second party to be used to control the billing of services provided within said access controlled environment" and fails to teach that "billing data indicates a first monetary amount associated with said services which is to be billed to [a] first party and a second monetary amount associated with said services which is to be billed to [a] second party."

The Examiner alleges that Bouvier supplies the missing elements of Joyce and references Column 13, lines 1-10 as support therefor. Incorporating the comments above regarding the inappropriate application of Joyce as the primary reference, the Applicant respectfully disagrees with the Examiner's characterization that Bouvier supplements the deficiencies of Joyce. For example, the portion relied upon by the Examiner recites claims 17 and 18 thereof:

> "17. A method according to claim 15, further involving generating a billing record for the call according to tariff information for the selected network access services.
> 18. A method of providing dialup network access services to users of a telephone system in which the operator of the telephone system implements the method of claim 17 and periodically bills said users for use of the telephone system and for the network access services accessed through the generic access service, the operator billing the network access services for the providers of those services."

See Bouvier, Column 13, lines 1-10.

The quoted language of Bouvier merely states that the operator of a telephone system may implement the claimed method and may bill a user for his or her usage of the telephone system and on behalf of the provider of the network access server, the operator

may also bill the user for his or her usage of the network access service. Support for Claims 17 and 18 of Bouvier may be found at Column 11, lines 6-21:

> "Although **from a user's standpoint it is preferable for billing of the telephone charges and network access charges to be made by one billing authority** such as the user's home PSTN operator, for practical reasons it may be simpler only to unify billing of network accesses made through different ASPs and to have the telephone charges handled separately. Thus, the SCP could pass network access details (for example, user id, ASP, network access server, QoS, duration of access, time of day) to an access broker running a server 55. Even if the PSTN remains responsible for billing, where the server 55 is run by an enterprise, that enterprise could be provided with access usage details of its employees by the PSTN in real-time--that is, upon an access call being terminated, a message would be sent to the server 55 recording the access details including user id, duration, access service used." (emphasis added).

See Bouvier, Column 11, lines 6-21.

The above-recited language of Bouvier does not support the Examiner's assertion that Bouvier supplements the deficiencies of Joyce. In contrast, Bouvier discloses and suggests that a first party (an operator of a telephone service) bill a second party (a user) for charges incurred by the user for using a telephone service associated with the operator and for charges associated with the provider of the network access server. Further, the "parties" of Bouvier are disparate to the "first party" and "second party" as recited in independent claims 1, 6, 11, 16 and 21 because the first user and the second user are not involved in the same transaction, that is, there is no correlation or association between the first party's transactions and the second party's transactions.

Bouvier and the language thereof cited by the Examiner **is also silent with regard to any allocation of the charges between multiple parties and the Examiner has not met his burden showing otherwise.** The combination of Joyce and Bouvier does not

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disclose or suggest the Applicant's claimed invention as set forth in independent claims 1, 6, 11, 16 and 21. For example, the "billing allocation scheme between a first party and second party," as defined by claims 1, 6, 11, 16 and 21, is not disclosed, suggested or taught by Bouvier alone or in combination with Joyce.

At page 15 of the Office Action, the Examiner states that both Joyce and Bouvier fail to teach or suggest the features in claims 1, 6, 11, 16 and 21 that are "associated with a particular transaction and wherein each of the first monetary amount and the second monetary amount are an amount greater than zero and the first party is different than the second party." The Examiner, however, alleges that Pickering supplies the missing elements of Joyce and Bouvier and cites Figure 4, the abstract, and Column 6, lines 18-65 of Pickering. The cited language of Pickering states, *inter alia*,

> "...if the customer instead remits $158.39, which is $13.80 less than the $172.19 total due, it can be assumed that the customer withheld the Part Due amount of $13.80 that was owed for payment of the previous month's Bell Telephone Company charge. In this instance, it is clear that customer intends to pay all current charges, but disputes a past charge.
> If the paid or unpaid amount cannot be tied to any particular company or utility, then the financial firm will remit to all the companies and utilities a pro-rata payment based on the partial payment. Simultaneously, all companies and utilities are notified of the pro-rata payment after which customer service may be used in order to resolve the billing dispute." (parenthetical references omitted).

It is clear that Pickering discloses an automated system and method for consolidating a plurality of individual company charges for a single customer or user. A central processing facility generates a single customer statement having a plurality of company charges (such as separate and distinct utility bills) on a single statement which is then sent to a single customer or user. Upon receipt of payment from a user, a

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centralized billing center processes the payment and remits the payment to the respective utility companies. *See* Pickering, Column 4, lines 30-53. The text of Bouvier relied upon by the Examiner (Column 6, lines 18-31) states that if a customer or user remits an amount less than the total required amount, i.e., the user disputes a past charge, and the system cannot tie the unpaid or paid amounts to any one company or utility, then the system remits a pro-rata payment to all the companies based on the partial payment. It would have been clear to one of ordinary skill in the art that **Pickering discloses and suggests billing only one user, a customer, with a consolidated statement from multiple utility companies**. **In contrast, Pickering does not disclose, teach or suggest the billing of services to more than one user or customer associated with a particular transaction** and the Applicant cannot find any motivation or suggestion in Pickering otherwise, as required in claims 1, 6, 11, 16, and 21 of the instant application. (*See* claims 1, 6, 11, 16 and 21 reproduced in relevant part on pages 3 and 4 of this Response). Thus, the Examiner has not only failed to meet his burden of showing that the cited prior art references, alone or in combination, disclose or suggest **each and every** claimed feature, but he has also failed to satisfy his burden of showing that there is some **suggestion or motivation** to one of ordinary skill in the art to modify the primary reference Joyce by either Bouvier or Pickering to render the claimed invention obvious.

Thus, the combination of Joyce, Bouvier and Pickering does not disclose, teach or suggest the Applicant's claimed invention, as set forth in independent claims 1, 6, 11, 16 and 21. As such, the Applicant respectfully requests that the Examiner withdraw his rejection of independent claims 1, 6, 11, 16, and 21 under 35 U.S.C. § 103(a) and allow

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the same to issue in a U.S. Patent.

Claims 2-5, 7-10, 12-15, 17-20 and 22-24 depend from independent claims 1, 6, 11, 16 and 21, respectively. Without regard to the additional patentable limitations contained therein, the Applicant respectfully requests that the Examiner also withdraw the rejections of claims 2-5, 7-10, 12-15, 17-20 and 22-24 under 35 U.S.C. § 103(a), and allow the same to issue in a U.S. Patent.
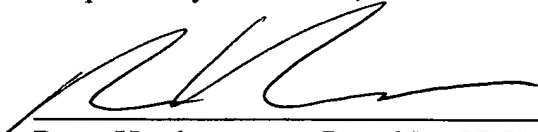
Conclusion

This Paper has been submitted in response to the Office Action mailed November 4, 2005. Claims 1-24 remain pending in the Application.

The Applicant believes that the Application is in condition for allowance and, as such, it is earnestly requested that claims 1-24 be allowed to issue in a U.S. Patent.

If the Examiner believes that an in-person or telephonic interview with the Applicant's representatives will expedite the prosecution of the subject patent application, the Examiner is invited to contact the undersigned agents of record.

It is believed that no fees are due in connection with the filing of this Paper. However, should any additional fees be necessary in connection with the filing of this Response, or if a petition for extension of time is required for timely acceptance of the same, such a petition is made and the Office is authorized to charge such fees to Deposit Account No. 04-1679.

Respectfully submitted,

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